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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,608	04/07/2000	Luke Hohmann	1531.0300001	9652

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EXAMINER

NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/545,608

Applicant(s)

HOHMANN ET AL.

Examiner

Quang N. Nguyen

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Detail Action***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/26/2004 has been entered.

Claims 1-20 are presented for examination.

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

3. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

4. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,623,679. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the cited claims of the US patent.

6. The following chart provides the correspondence between the claims of the application and the claims of the patent:

Application 09/545,608	U.S. Patent 5,623,679
<p data-bbox="196 667 792 699"><b>Claim 1:</b></p> <p data-bbox="196 741 792 1066">a database having stored therein at least one intellectual asset protocol defining at least one data exchange set of rules and formats for a type of intellectual asset data object; and</p> <p data-bbox="196 1465 792 1791">at least one engine, wherein said at least one engine determines whether an intellectual asset data object of said type conforms to said intellectual asset protocol.</p>	<p data-bbox="828 667 1421 699"><b>Claim 1:</b></p> <p data-bbox="828 741 1421 1360">(2) a storage device for storing at least one patent text document comprised of an equivalent text file and at least one patent image, said equivalent text file including linking information and equivalency information (i.e., rules and formats) detailing an equivalency relationship between said patent image file and a corresponding patent text file.</p> <p data-bbox="828 1465 1421 1507">(1) a central processing unit (CPU).</p>

<b>Claim 2:</b>  said type of said intellectual asset data object is selected from the group of a patent, a patent application, a trademark, a trademark application, etc.	<b>Claim 1:</b>  a storage device for storing at least one patent text document (UNIX database 11 of Fig. 1).
<b>Claim 3:</b>  said database is accessible through the Internet.	<b>Claim 1:</b>  said storage device (said UNIX database 11 is a USPTO database) accessible by users over the Internet.
<b>Claim 4:</b>  said database is relational.	<b>Col. 20, lines 8-17:</b>  discuss creation of a Volume Table of Contents from the PTO Text Tapes (i.e., storage device in claim 1) having multiple patents. The VOTC is used to update a Relational Database System for future reference.

<b>Claim 5:</b>  said database supports hypertext references.	<b>Claim 1:</b>  (4) note creation means for enabling a user to create note and to link said note to any patent text document stored in said storage device.
<b>Claim 6:</b>  objects within said protocol conform to at least one Extended Markup Language (XML) Document Type Definition (DTD)	<b>Col. 17, lines 40-47:</b>  the underlying structure of the information stored in the equivalent text file in claim 1 to be stored in a general markup language such as SGML (wherein XML is a pared-down version of SGML).
<b>Claim 7:</b>  said DTD comprises a union of structured bibliographic data of said intellectual asset data objects.	<b>Claim 5:</b>  bibliographic formatting information specifying an approximate arrangement of bibliographic data contained in said patent text file as displayed in bibliographic page images in said patent image file.

<b>Claim 8:</b>  input for receiving intellectual asset data objects, a format of said input intellectual asset data objects being normalized for entry into said database.	<b>Col. 11, line 10 to Col. 12, line 8:</b>  extracting/receiving from PTO magnetic tapes PTO text files and PTO image files which then being paginated to produce and index the corresponding PTO Equivalent Files in claim 1 to be stored in the database 11.
<b>Claim 9:</b>  output for presenting information from said intellectual asset data objects.	<b>Claim 1:</b>  (3) means for displaying said patent text document in a first window of said display unit and said patent image document in a second window of said display unit.



7. Claims 10-20 are corresponding system and method claims of claims 1-9; therefore, they are rejected under the same rationale.

8. This application is in condition for allowance except for the following formal matters:


- I. Applicant is requested to file a terminal disclaimer.
- II. Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- III. A shortened statutory period for reply to this action is set to expire TWO MONTHS from the mailing date of this letter.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Quang N. Nguyen

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER